

### **REMARKS**

Claims 1-6 were examined and reported in the Office Action. Claims 1 and 4-6 are rejected. Claims 1-3 are amended to correct a typographical error and to conform to standard practice. Claims 1-6 remain.

Applicant requests reconsideration of the application in view of the following remarks.

#### **I. 35 U.S.C. §102(b)**

It is asserted in the Office Action that claims 1, 4-6 are rejected under 35 U.S.C. §102(b) as being anticipated by U. S. Patent No. 6,272,343 issued to Pon et al ("Pon"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2131,

[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' (Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' (Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, *i.e.*, identity of terminology is not required. (In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)).

Applicant's claim 1 contains the limitations of

a method for selecting a wireless communication system, the method comprising:... if there are any available wireless communication system having identical system type as a result of the determining, selecting a wireless communication system having highest priority in the PRL by searching wireless communication system in the first service area and a plurality of second service areas neighbored to the first service area and comparing priorities of wireless communication systems in the first service area and second service areas;...

In other words, in case when there are available wireless communication systems having an identical system type, Applicant's claimed invention selects a wireless communication system having the highest priority in the preferred roaming list (PRL) by searching not only wireless communication systems in the first service area, but also wireless communication systems in a plurality of second service areas neighbored to the first service area; and comparing priorities of wireless communication systems in the first service area and second service areas.

Pon discloses a method and apparatus for fast signal acquisition on a channel belonging to a preferred service provider when the channel is available. Pon further discloses selecting the preferred wireless frequency channel, where selecting includes: (a) selecting a highest priority level in the multi-level system of identifiers; (b) checking a channel level with the first highest priority including a first plurality of channels to achieve the preferred connection; (c) if a preferred connection is not achieved in the step (b), checking a channel level with the second highest priority including a second plurality of channels to achieve preferred connection; (d) if a preferred connection is not achieved in the step (c), checking consecutively each channel level with the  $i3$ -th priority including an  $i3$ -th plurality of channels to achieve preferred connection,  $i3$  is an integer greater than two and less than or equal to  $N$ ; (e) if a preferred connection is not achieved, selecting the next highest priority level in the multi-level system of identifiers; and (f) repeating the steps (b-e). (See Pon, column 4, lines 14-65). Pon, however, is silent regarding the step in case when there are available wireless communication systems having identical system type.

Specifically, Pon merely discloses a channel based selection by checking a channel level. Pon, however, does not teach, disclose or suggest searching not only wireless communication systems in the first service area but also wireless communication systems in a plurality of second service areas neighbored to the first service area and comparing priorities of wireless communication systems in the first service area and second service areas in case that there are available wireless communication systems having identical system type.

Therefore, since Pon does not disclose, teach or suggest all of Applicant's amended claim 1 limitations, Applicant respectfully asserts that a *prima facie* rejection under 35 U.S.C. § 102(b)

has not been adequately set forth relative to Pon. Thus, Applicant's amended claim 1 is not anticipated by Pon. Additionally, the claims that directly or indirectly depend on claim 1, namely claims 4-6, are also not anticipated by Pon for the same reason.

Accordingly, withdrawal of the 35 U.S.C. §102(b) rejection for claims 1, 4-6 is respectfully requested.

**II. Allowable Subject Matter**

Applicant notes with appreciation the Examiner's assertion that claims 2-3 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant respectfully asserts that claims 1-6, as they now stand, are allowable for the reasons given above.

**CONCLUSION**

In view of the foregoing, it is believed that all claims now pending, namely 1-6, patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly extension of time fees. If a telephone interview would expedite the prosecution of this Application, the Examiner is invited to contact the undersigned at (310) 207-3800.

Respectfully submitted,

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Dated: March 29, 2006

By: \_\_\_\_\_

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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450 on March 29, 2006.

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Jean Svoboda